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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,713	12/29/1999	GREGORY R.J. THATCHER	1995-033-12U	1352

7590

10/24/2002

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/473,713	Applicant(s) THATCHER ET AL.	
	Examiner Cybille Delacroix-Muirheid	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20,22,24,26,28 and 33-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-40 is/are allowed.
- 6) ☒ Claim(s) 11-20,22,24,26,28,41 and 42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u> . | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

The following is responsive to Applicant's amendment received Jul. 16, 2002.

No claims are cancelled. New claims 41 and 42 are added.

Claims 11-20, 22, 24, 26, 28, 33-42 are currently pending.

The previous claims rejection under 35 USC 112, paragraph 2, set forth in paragraph 1 of the office action mailed Jan. 16, 2002 is withdrawn in view of Applicant's amendment and the remarks contained therein.

The previous claims rejection under 35 USC 102(a) set forth in paragraphs 2-3 of the office action mailed Jan. 16, 2002 is withdrawn in view of Applicant's amendment and the remarks contained therein.

Information Disclosure Statement

Applicant's Information Disclosure Statement received Jan. 16, 2002 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

Claim Objections

1. Claim 13 is objected to because of the following informalities: in claim 13, page 7, lines 1-16, the use of the parentheses around some of the claim language throughout the claim is awkward. The Examiner respectfully suggests that Applicant cancel these parentheses.

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

2. Claims 11-20, 22, 24, 26, 28, 41, 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 11 and 12 recite the limitation "formula I" in line 8. There is insufficient antecedent basis for this limitation in the claim. There is no "Formula I" in the claims. Therefore, it is not clear to what formula Applicant is referring.

In claim 13, at page 7, lines 11-12, the limitation "containing carbonyl linkages (C=O, C=S, C=NOH)" renders the claim indefinite because it is unclear whether the limitations in the parentheses following the phrase "containing carbonyl linkages" are part of the claimed invention. See MPEP § 2173.05(d). However, if the limitations within the parentheses are a part of the claimed invention, it appears that the limitation within the parentheses is narrower and follows the broader limitation "containing carbonyl linkages." It has been held that a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. This can render a claim indefinite by raising a question or doubt as to whether the limitations within the parentheses are (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ

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74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). The Examiner respectfully suggests amending claim 13 to read, for example, --containing carbonyl linkages selected from the group consisting of C=O, C=S and C=ONH--.

In claims 11, 12, 14, 15, 41, 42, the last line, the limitation "wherein R^{NN} is a short chain alkyl group (C1-C12)" renders the claim indefinite for the same reasons given above. The Examiner would respectfully suggest amending this limitation to read --wherein R^{NN} is a C1-C12 alkyl group--.

Conclusion

Claims 11-20, 22, 24, 26, 28, 41, 42 are rejected.

Claims 33-40 are free from the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

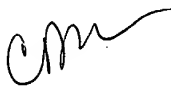
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM



Oct. 21, 2002



Cybille Delacroix-Muirheid
Patent Examiner Group 1600